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EXAMINER	
GRAYSAY, TAMARA L	
ART UNIT	**PAPER NUMBER**
3636	

DATE MAILED: 03/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/929,398	KRYSINSKI ET AL.	
	Examiner	Art Unit	
	Tamara L. Graysay	3636	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 November 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-27* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-27* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *28 November 2005* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Preliminary Matter

1. The amendment filed 28 November 2005 has been entered. The rejection under 35 U.S.C. 101 and related lack of structure rejection under 35 U.S.C. 112, second paragraph, have been obviated by the response.

The amendment to the specification by replacement of the paragraph beginning at page 3, line 7, has been entered even though the replacement paragraph does not fully comply with 37 CFR 1.1.21(b). In particular, at the fourth sentence, applicant has changed [twoof] to two of without proper markings as required by 37 CFR 1.121(b)(1)(ii).

Drawings

2. The drawings were received on 28 November 2005. These drawings are not acceptable.

3. The drawings are objected to because of the following:

a. They fail to comply with 37 CFR .184(h)(2) because a smaller scale view should be included showing the whole formed by the partial views and indicating the position of the parts shown. In the present application, Figures 4 and 5A-5E and 6 appear to be partial views; however, there is no smaller scale view showing the whole.

b. They fail to comply with 37 CFR .184(h)(2)(i) because the views on the several sheets must be so arranged that the complete figure can be assembled without concealing any part of any of the views appearing on the various sheets. In the present application,

the partial views illustrated in Figures 4 and 5A-5E and 6 cannot be assembled without concealing any part of the other partial views.

c. They fail to comply with 37 CFR 1.84(u)(1) because Figures 4 and 5A-5E and 6 appear to be partial views intended to form one complete view; however, they are not identified by the same number.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1-13, 22-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Caruso (article, Children's hospital shines light on net problems).

a. Claim 1: Caruso discloses a method including the steps of providing a data capture device (NerveCenter) proximate (building 1 and building 2, for example) to a

business machine (uninterruptible power supply or UPS)[software collects information, 27:B:4]; automatically determining a threshold event (utilization is high, batter is low, power failure)[27:B:5,6]; programming the threshold event into the data capture device [27:B:5,6]; receiving notification (manager notified by pager) of triggering of the threshold event [27:B:6]; reporting information related to the contract electronically and automatically to the user (the company) based at least in part on the receiving step (lists users and devices, highlights events)[27:B:6].

Caruso does not mention the type of agreement used in maintaining the system. However, the term service contract has been interpreted broadly to mean any service(s), process(es), or act(s), whether in-house or outsourced by a person performing the method. A contract is an abstract idea, and as such, has not been claimed *per se*, but rather the process of implementing a service is claimed. Even if a service contract were required by the claim, it is common business practice to outsource services that are neither familiar to a company nor within its expertise. Such an arrangement is used in order for a company to remain focused on its organizational goals. In the second interpretation which gives some weight to outsourcing of a service act, the claimed subject matter would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Caruso to include the common business practice of outsourcing in order to remain focused on in-house organizational goals.

b. Claim 2: Caruso discloses receiving a service call by a technician (manager) automatically generated from user (company) input [27:B:6, the manager is notified of a problem automatically]. The user input in the Caruso reference is a signal from the UPS.

c. Claim 3: Caruso discloses the use of pagers, which are wireless devices, to notify the technician [27:B:6].

d. Claim 4: The examiner takes Official notice that it is well known in business that business contact each other, and more specifically that a service provider would contact an entity receiving services. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Caruso to include the step of contacting the company by a technician, in order for the technician to perform the needed services.

e. Claim 5: The examiner takes Official notice that web interfaces are a common way for users to interface with a computer system. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Caruso to include a web interface on the network to enable a user to input information and to graphically receive information via the computer network.

f. Claim 6: The use of automatic contract renewals is common in business to prevent lapse of critical or important agreements among parties. Therefore, it would have

been obvious to one of ordinary skill in the art at the time the invention was made to modify Caruso to include provision for automation of renewals in order to prevent lapse of critical or important agreements among parties.

g. Claim 7: The claimed "point remote to" is a relative term that was met by Caruso which depicts a keyboard separate from the NerveCenter hard drive.

h. Claim 8: The determining step is performed remote to the data capture device insofar as the UPS sends information that is used to determine whether a critical event happened [27:B:6].

i. Claim 9: Caruso discloses an embodiment in which a user may call the help desk for assistance or to report a critical event. Although Caruso improves upon the method of manual activation, by placing a call to the help desk, the disclosure of Caruso as a whole teaches a combination of manual and automatic requests for service when a critical event occurs. Further, the structural modification of the data capture device is not manipulated by the method and as such is not given patentable weight in the method or process claims.

j. Claim 10: Caruso includes a wireless transceiver that is used to page the manager when a critical event happens [27:B:6]. Further, the structural modification of the data

capture device is not manipulated by the method and as such is not given patentable weight in the method or process claims.

k. Claim 11: The term contract has been interpreted broadly to mean any service(s), process(es), or act(s), whether in-house or outsourced by a person performing the method. Caruso discloses a percentage of contract, for example, 85% utilization of the link [27:B:6].

l. Claim 12: Caruso discloses a method that includes lists. In order to determine the items included on the list, the data capture device inherently performs the step of querying for information.

m. Claim 13: Caruso includes the steps of remotely monitoring usage of supplies (determining when batteries are low, for example)[27:B:5], and notifying the user when ordering supplies is predicted to be warranted (the manager is notified when the batteries are low)[27:B:6].

n. Claim 22: Caruso discloses a method including the steps of providing a data capture device (NerveCenter) proximate (building 1 and building 2, for example) to a business machine (uninterruptible power supply or UPS)[software collects information, 27:B:4]; generating a service call automatically from the data capture device (the manager is notified of a critical event via a pager system)[27:B:6]; determining a

threshold event (utilization is high, batter is low, power failure)[27:B:5,6]; programming the threshold event into the data capture device [27:B:5,6]; programming the receiving a service call by a technician (manager) automatically generated from user (company) input [27:B:6, the manager is notified of a problem automatically and the user input in the Caruso reference is a signal from the UPS]; wirelessly notifying a technician of the service call for the business machine (pagers, which are wireless devices, are used to notify the technician)[27:B:6].

Caruso lacks the feature whereby the user can be contacted by the technician based upon the wirelessly notifying step. However, the examiner takes Official notice that it is well known in business that business entities contact each other, and more specifically that a service provider would contact an entity receiving services. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Caruso to include the step of contacting the company by a technician, in order for the technician to perform the needed services.

Caruso does not mention the type of agreement used in maintaining the system. However, the term service contract has been interpreted broadly to mean any service(s), process(es), or act(s), whether in-house or outsourced by a person performing the method. A contract is an abstract idea, and as such, has not been claimed *per se*, but rather the process of implementing a service is claimed. Even if a service contract were required the outsourcing of services that are neither familiar to a company nor within its expertise is well known in the business field in order for a company to remain focused on its organizational goals.

o. Claim 23: Caruso discloses receiving notification (manager notified by pager) of triggering of the threshold event [27:B:6]; and reporting information related to the contract electronically and automatically to the user (the company) based at least in part on the receiving step (lists users and devices, highlights events)[27:B:6].

p. Claim 24: Caruso discloses a malfunction as the threshold event (power failure [27:B:6], low battery [27:A:4], bad network card [27:C:7], link utilization [27:B:2,6].

q. Claim 25: Caruso discloses an embodiment in which a user may call the help desk for assistance or to report a critical event. Although Caruso improves upon the method of manual activation, by placing a call to the help desk, the disclosure of Caruso as a whole teaches a combination of manual and automatic requests for service when a critical event occurs. Further, the structural modification of the data capture device is not manipulated by the method and as such is not given patentable weight in the method or process claims.

r. Claim 26: The examiner takes Official notice that web interfaces are a common way for users to interface with a computer system. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Caruso to include a web interface on the network to enable a user to input information and to graphically receive information via the computer network.

s. Claim 27: The business machine in Caruso is a multifunction device, as broadly recited, insofar as the UPS device both guards against power failure and provides back up power if there is a power failure.

5. Claims 14, 15, 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fraker (US-5919239).

a. Claim 14: Fraker discloses a plurality of data capture devices (e.g., logging system 10, including memory 22); each data capture device coupled to a business machine (e.g., 106); and each data capture device comprises a wireless transceiver (e.g., 76); an operations center (e.g., 14, 90) in two-way communication (e.g., 76 to 82) with each data capture device, wherein the operations center determines a threshold and communicates that threshold to one of the data capture devices (e.g., abstract, the apparatus may include a radio transceiver for exchanging data and/or programming information); and a web interface to the operations center (e.g., represented by screen 94).

Fraker lacks a threshold related to a service contract. However, Fraker does include a monitoring the business machine (e.g., vehicle engine temperature) and determines its relationship to a threshold (e.g., 9:37-10:2). The examiner takes Official notice that vehicles are serviced whether routinely or preventatively and that service for

fleet vehicles is commonly performed under a service contract in order to ensure that the vehicles are maintained to avoid unexpected unavailability.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Fraker to include a threshold defined by a service contract in order to determine when a vehicle is in need of service.

b. Claim 15: a vehicle is inherently a multifunction device, as broadly recited.

c. Claim 17: Fraker does not assign a technician (driver) to each business machine (vehicle), however, assigning a technician is inherent in Fraker because each vehicle would always and necessarily have a technician assigned thereto.

d. Claim 18: Fraker discloses the data capture device as part of the business machine (vehicle), but stops short of the data capture device being integral thereto. The term "integral" is sufficiently broad to embrace constructions united by such means as fastening and welding (in re Hotte (C.C.P.A.) 157 U.S.P.Q. 326); the term is not necessarily restricted to a one-piece article (in re Kohno (C.C.P.A.) 157 U.S.P.Q. 275); and may be construed as relatively broad (in re Dike (C.C.P.A.) 157 U.S.P.Q. 581).

e. Claim 19: Fraker depicts one service terminal; however, the number of service terminals is a matter of design choice that is within the level of ordinary skill in the business field and would, for example, be dependent upon the regional or quantitative

parameters of the business machines (vehicles). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Fraker to include a plurality of wireless service terminals to accommodate all users.

f. Claim 20: the data capture device comprises a mechanism for sending a signal to the operations center. The statement of intended use for the mechanism is not given patentable weight insofar as the mechanism is not in means plus function language.

6. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fraker (US-5919239) in view of Mazzapica (cited by applicant, US-5930342).

Fraker is for managing vehicles, i.e., outdoor business machines, rather than generally indoor office machines. Mazzapica teaches management of business machines including copiers and fax machines including maintenance and unauthorized movement or use. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Fraker to include a fax or copier, i.e., business machines that are generally used indoor rather than outdoor, such as suggested by Mazzapica, in order to monitor location and maintain operability of the indoor machines.

7. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fraker (US-5919239) in view of Gralla (book, How the internet works).

Fraker discloses the transceiver and operations center coupled via a public access medium. A wide area network is a type of public access medium, as evidenced by the wide area network in Gralla. A wide area network is a public access medium that connects electronic devices among many sites. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Fraker to include a wide area network public access medium, such as suggested by Gralla, in order to connect devices that are remotely located at different sites.

Response to Arguments

8. Applicant's arguments filed 28 November 2005 have been fully considered but they are not persuasive.

a. Page 14-15: Applicant argues [p.**14**] that Caruso lacks the "automatically determining a threshold event that is programmed" limitation. For clarification, the argument is presumed to mean the two steps: determining a threshold event and programming the threshold event, are not supported by Caruso. Applicant further argues [p.**15**] that applicant's claimed subject matter is distinct from the claimed invention because Caruso threshold events are most likely either predetermined or determined manually.

In response, first, applicant's argument that automatically determining is a feature that distinguishes over predetermined or manually determined is not persuasive because the claim does not preclude predetermined or prior manually determined threshold events. In fact applicant's specification mentions threshold events being loaded on the data capture device before any automatically generating, automatically scheduling, or automatically initiating [**2**:30-33]. Looking to the original application the automatic steps in the original application do not preclude predetermined threshold events. For example:

- Automatically generating a message, bill, service call, etc [**2**:30-31]; automatically scheduling and dispatching service calls after they are reported [**2**:31-32]; and automatically initiating the service call by the data capture device [**2**:32-33]. The foundation of the automatic nature of these automatic steps is based on threshold events loaded on the data capture device [**2**:28-30].

- Automatically generating reauthorization requests [**6**:22-23]. The foundation of the automatic nature of this automatic step is based on information entered by the user as it related to the billing function [**6**:13-17].
- Automatically shipping supplies [7:18-19] which similarly requires data to be input into the data capture device for predicting supply needs, i.e., a threshold.

None of these automatic features is explicitly related to the step of automatically determining and programming. Moreover, the step of automatically determining does not preclude predetermined because automatically broadly includes predetermined thresholds as noted earlier in this paragraph. Thus, applicant's argument that the claimed "automatically determined" and "programming" steps distinguish over Caruso is not persuasive.

Second, as explained in paragraph (5) above Caruso discloses the step of automatically determining a threshold event wherein the determining is, for example, high utilization, low battery, or power failure [Caruso 27:B:5,6]. Further, Caruso discloses the step of programming the threshold event into the data capture device insofar as the uninterruptible power supplies are configured to send a message to the nerve center when power fails or the batteries are low and alternatively managers are notified by email when utilization on a link becomes high [Caruso 27:B:5,6]. In order for the message or notification to occur, the NerveCenter data capture device must always and necessarily be programmed with the information that determines a threshold associated with power failure, low battery, high utilization.

Third, the original specification reads, "operations center 104 determines the threshold events and programs the data capture device 116 remotely, but some embodiments could enter some of the threshold events by direct connection to the data capture device 116 [4:1-3]. The newly added claim limitation of "automatically" determining is not further explained other than as possibly distinguishing over direct input to the data capture device. The distinction brought out in the original disclosure is merely one of programming the data capture device via the operations center or programming the data capture device directly. There is no further explanation of the automatic nature of the "determining" step.

Last, applicant has grounded the argument of why the claimed feature of "automatically determining" and "programming" in limitations that are not included in the scope of the claim, i.e., not predetermined; however, the argument is not persuasive in light of the silence of the original disclosure to that end.

b. Page 14: Applicant argues that the grounds of rejection lack motivation to mix and match portions of Caruso. In response, the rejection is not a mix and match approach. The reference is several columns long and describes the system and its operation in detail. To that end, the detailed discussion of how the reference meets the claimed subject matter particularly refers to portions of the Caruso reference, as appropriate, in accordance with current patent examination practice.

c. Page 15: Applicant argues there is no suggestion or motivation to modify or to combine references. The Caruso reference has been applied under 103 because the claim has been interpreted as including a service contract. As such the discussion of the reference includes the dual interpretation of the claim whereby the contract itself is not given weight other than it has been interpreted as any service, process, or act; and whereby the contract as claimed is representative of outsourcing services. As such, the act of outsourcing services is presented as well known in the business field. Therefore, if the second interpretation which gives some weight to outsourcing of a service act, then the claimed subject matter would have been obvious to one of ordinary skill in accord with that which is well known as noted in the above rejection.

d. Page 16: Applicant argues that a Fraker user does not participate in any interaction between the control computer and command center. The claim is an apparatus claim, which does not include a user in its scope. The argument does not particularly point out any structural distinctions between the prior art and the claimed subject matter. Regarding the term "remote," applicant has not particularly pointed support for the added limitation in the original disclosure. The term has been given its broadest reasonable interpretation which includes the structure presented in Fraker, e.g., command center office / portable computer 90 which is remote from the base station 84.

e. Page 16: Applicant argues that Fraker lacks a monitoring system that "communicates" the threshold with the vehicle. In response, applicant agrees that the rise

in engine temperature generates a programming signal to an operational program and notifies when there is a threshold event. The claimed operations center in two way communication with each data capture device is met by Fraker's operations center 14, 90 in two way communication with the wireless transceivers 76 as discussed in the rejection above.

f. Page 17: Applicant requests express showing of documentary proof of the Official notice taken at page 14, paragraph 6 of the previous Office action. Applicant's request has been reviewed using the same standard as a traversal of the examiner's assertion set forth in MPEP § 2144.03 C. To adequately traverse a factual assertion as not properly officially noticed or not properly based upon common knowledge, applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. (emphasis added). See 37 CFR 1.111(b). See also *In re Chevenard*, 60 USPQ 239, 241 (CCPA 1943).

The Official notice in paragraph (5) above is taken to be admitted prior art because applicant has not stated why the noticed fact is not considered to be common knowledge or well-known in the art, i.e., applicant's traversal is not adequate.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamara L. Graysay whose telephone number is 571-272-6728. The examiner can normally be reached on Mon - Fri from 8:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter M. Cuomo, can be reached on 571-272-6856. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tamara L. Graysay 2/21/06
Examiner
Art Unit 3636

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